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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/555,663	12/04/2006	Shigenori Fujikawa	1248-1030PUS1	9919

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EXAMINER

SCHIFFMAN, BENJAMIN A

ART UNIT	PAPER NUMBER
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1791

NOTIFICATION DATE	DELIVERY MODE
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11/30/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/555,663	Applicant(s) FUJIKAWA ET AL.	
	Examiner BENJAMIN SCHIFFMAN	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6 and 8-19 is/are pending in the application.
- 4a) Of the above claim(s) 10-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8,9 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/18/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The papers submitted 10 September 2009 amending claims 1 and canceling claims 2 and 7 are acknowledged.

Election/Restrictions

2. Applicant's election with traverse of group I, claims 1-9, in the reply filed on 10 September 2009 is acknowledged. The traversal is on the ground(s) that examination of the entire application can be made without serious burden. This is not found persuasive because it does not address the independence or distinctness of the inventions or all sources of burden imposed by the inventions. A serious burden on the examiner may be prima facie shown by appropriate explanation of separate classification, or separate status in the art, or a different field of search. Arguments of convenience or coextensiveness are insufficient showing to demonstrate that there is no undue burden.

3. The requirement is still deemed proper and is therefore made FINAL.

Foreign Priority

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1, 3, 8, 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cuisin et al. (*Fabrication of three-dimensional photonic structures with submicrometer resolution by x-ray lithography*) in view of Fujikawa et al. (*Surface Fabrication of Interconnected Hollow Spheres of nm-Thick Titania Shell*).

9. Regarding claim 1, Cuisin discloses a method of forming a submicrometer, i.e. nanometer, material (**see abstract**) with the steps of forming a mold by a lithographic method on a substrate, in this case the mold is formed in a layer of PMMA deposited upon Si/SiC/W substrate (**see pp. 3506-7, section II**); forming a metal oxide on the

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PMMA layer, i.e. forming a organic/metal oxide composite layer; and finally removing the PMMA layer, to form a metal oxide submicrometer structure (**see p. 3508, section IV**).

10. Cuisin does not appear to explicitly disclose that the oxide film is formed by bringing a metal compound capable of reaction with hydroxyl or carboxyl groups present into contact with a forming surface and hydrolyzing the metal compound to obtain the oxide. Although Cuisin does describe that the oxide is formed by a sol-gel process, which is a process of bringing a liquid precursor containing a metal compound into contact with a surface and hydrolyzing the metal compound to form a metal oxide.

11. However, Fujikawa discloses a method of forming a nanostructure (**see title**) wherein oxide thin film is formed on latex beads forming an organic/metal oxide film the latex having a carboxylated surface and the titania film is formed on the latex surface through a sol-gel process (**see p. 1134**).

12. At the time of invention, it would have been *prima facie* obvious to one of ordinary skill in the art to modify the method of Cuisin to include the carboxylated surface of Fujikawa, because the sol-gel technique is a known method of applying metal oxide thin films and would obtain predictable results.

13. Regarding claim 3, Cuisin discloses that the PMMA mold, i.e. the organic portion of the organic/metal oxide composite, is removed (**see pp. 3508, section IV**).

14. Regarding claim 8, Cuisin discloses that the mold is formed in PMMA, i.e. an organic compound (**see pp. 3506-7, section II**).

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15. Regarding claim 9, Cuisin discloses that the mold of PMMA is removed by calcination, i.e. baking (**see p. 3508, section IV**).

16. Regarding claim 19, Fujikawa discloses that the latex is removed by exposure to oxygen plasma after the forming the oxide layer (**see p. 1134 col. 2 bottom to p. 1135 col. 1 first paragraph and fig. 3**).

17. Claim 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cuisin et al. (*Fabrication of three-dimensional photonic structures with submicrometer resolution by x-ray lithography*) in view of Fujikawa et al. (*Surface Fabrication of Interconnected Hollow Spheres of nm-Thick Titania Shell*) as applied to claim 1, and further in view of Li et al. (*A High-Rate, High-Capacity, Nanostructured Sn-Based Anode Prepared Using Sol-Gel Template Synthesis*).

18. Cuisin discloses a method of forming nanostructure as described in the 102(b) rejections of claim 1 and 3 above.

19. Cuisin does not appear to explicitly disclose a step of removing the substrate from the mold/organic portion of the organic/metal oxide composite.

20. However, Li discloses a method of making nanostructures (**see abstract**) with the step of removing the metal oxide nanostructure from the substrate (**see p. A165 col. 1**).

21. At the time of invention, it would have been *prima facie* obvious to one of ordinary skill in the art to modify the method of Cuisin to include the substrate removal step of Li, in order to inspect the formed nanostructure with a TEM (**see p. A165 col. 1**).

22. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cuisin et al. (*Fabrication of three-dimensional photonic structures with submicrometer resolution by x-ray lithography*) in view of Fujikawa et al. (*Surface Fabrication of Interconnected Hollow Spheres of nm-Thick Titania Shell*) as applied to claim 1, and further in view of Kenausis et al. (*Poly(l-lysine)-g-Poly(ethylene glycol) Layers on Metal Oxide Surfaces: Attachment Mechanism and Effects of Polymer Architecture on Resistance to Protein Adsorption*).

23. Cuisin discloses a method of producing a nanostructure as discussed in the above 102(b) rejection of claim 1.

24. Cuisin does not appear to expressly disclose covering at least a portion of nanostructure, or the mold/organic portion.

25. However, Kenausis discloses a polymer coating for a metal oxide surface (**see abstract**).

26. At the time of invention, it would have been *prima facie* obvious to one of ordinary skill in the art to modify the method of Cuisin to include the coating of Kenausis, in order to convert the oxide from a strongly interactive surface to a noninteractive surface in applications such as biomaterials (**see abstract**).

Response to Arguments

27. Applicant's arguments filed 10 September 2009 have been fully considered but they are not persuasive.

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28. Regarding claim 7, which has been incorporated into amended claim 1, applicant argues that there is no motivation for the combination of Cuisin and Fujikawa, specifically because a person skilled in the art would consider that the hydroxyl/carboxyl group are present before the mold is formed and would undergo a chemical change. However, it is noted that the features upon which applicant relies (i.e., that the resist layer is formed is not subjected to the lithographic/mold forming step) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, Cuisin explicitly discloses that the metal oxide is formed on the PMMA template from a metal oxide *precursor* by a sol-gel process (**see p. 3508 section IV**), and not directly from a solution of metal oxide as described by applicant. Cuisin does not explicitly describe the chemical phenomenon in the sol-gel process and thus one of ordinary skill would have been motivated to look to Fujikawa which discloses a similar sol-gel technique. Still further, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Finally, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413,

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208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

29. With respect to claims 3-6, 8 and 9, applicant presents no further arguments other than those addressed above with respect to claim 1.

Conclusion

30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yoldas (*Deposition and properties of optical oxide coatings from polymerized solutions*) is cited by Cuisin et al. in regard to a sol-gel technique.

31. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

32. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN SCHIFFMAN whose telephone number is (571)270-7626. The examiner can normally be reached on Monday through Thursday from 9AM until 4PM.

34. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHRISTINA JOHNSON can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

35. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BENJAMIN SCHIFFMAN/
Examiner, Art Unit 1791

/Christina Johnson/
Supervisory Patent Examiner, Art Unit 1791